REMARKS/ARGUMENTS

Reconsideration of this Application and entry of this Amendment after Final are respectfully requested. The proposed amendment places the claims in better form for appeal. Additionally, this amendment addresses items brought up by the examiner in the final office action. Claims 1, 3-6, and 8-25 are pending in the present Application. In the Office Action mailed January 14, 2009, the Examiner rejected pending claims 1, 3-6, and 8-25 on various grounds. Claims 1, 6, 11, 18, and 22 are amended herein. In view of the amendments and following remarks, favorable consideration and allowance of the application is respectfully requested.

35 U.S.C. §102 Rejections

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Thus, to warrant the §102 rejection, the references cited by the Examiner must show each and every limitation of the claims in complete detail. The Applicant respectfully asserts that the cited references fail to do so.

A. Claims 1, 3-6, and 8-10 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. No. 6,616,765 to Castro, *et al.* (the *Castro* patent).

The Applicant respectfully asserts that the *Castro* patent fails to teach or suggest all the claim limitations.

The *Castro* patent fails to disclose, teach, or suggest:

> a stent delivery system including a stent having a plurality of end-to-end cylindrical stent segments, the axes of the plurality of cylindrical stent segments lying along a longitudinal axis of the stent, the stent having a first region continuous across at least one pair of adjacent cylindrical stent segments and a second region continuous across at least one pair of adjacent cylindrical stent segments; a first coating section, the first coating section disposed on and

completely covering the outer surface of the adjacent cylindrical stent segments in the first region and comprising a first polymer; and a second coating section, the second coating section disposed on and completely covering the outer surface of the adjacent cylindrical stent segments in the second region and comprising a second polymer; wherein the first region and the second region are discrete, and the first coating section and the second coating section are discrete, as recited in independent claim 1; or

a coated stent including a stent having a plurality of end-to-end cylindrical stent segments, the axes of the plurality of cylindrical stent segments lying along a longitudinal axis of the stent, the stent having a first region continuous across at least one pair of the adjacent cylindrical stent segments and a second region continuous across at least one pair of the adjacent cylindrical stent segments; a first coating section, the first coating section disposed on and completely covering the outer surface of the adjacent cylindrical stent segments in the first region and comprising a first polymer; and a second coating section, the second coating section disposed on and completely covering the outer surface of the adjacent cylindrical stent segments in the second region and comprising a second polymer; wherein the first region and the second region are discrete, and the first coating section and the second coating section are discrete, as recited in independent claim 6.

At most, the *Castro* patent discloses that composition 10 is applied into cavities 78 within surface 70 of prosthesis 12. *See* column 16, lines 35-37; column 16, lines 35-37; Figures 11A-12D, 13F-13H, 14E, and 14F.

Claims 3-5 and claims 8-10 depend directly or indirectly from independent claims 1 and 6, respectively, and so include all the elements and limitations of their respective independent claims. The Applicant therefore submits that the dependent claims are allowable over the *Castro* patent for at least the same reasons as set forth above with respect to their independent claims.

Withdrawal of the rejection of claims 1, 3-6, and 8-10 under 35 U.S.C. §102(e) as being anticipated by the *Castro* patent is respectfully requested.

35 U.S.C. §103 Rejections

Obviousness is a question of law, based on the factual inquiries of 1) determining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. *Graham v. John Deere Co.,* 383 U.S. 1, 148 USPQ 459 (1966). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *See* MPEP 2143.03. The Applicants respectfully assert that the cited references fail to teach or suggest all the claim limitations.

B. Claims 11-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over the *Castro* patent.

The Applicant respectfully asserts that the *Castro* patent fails to teach or suggest all the claim limitations.

The *Castro* patent fails to disclose, teach, or suggest:

> a method for producing a coated stent including providing a stent having a plurality of end-to-end cylindrical stent segments, the axes of the plurality of cylindrical stent segments lying along a longitudinal axis of the stent, the stent having a first region continuous across at least one pair of adjacent cylindrical stent segments and a second region continuous across at least one pair of adjacent cylindrical stent segments; mixing a first polymer and first therapeutic agent with a first solvent to form a first polymer solution; applying the first polymer solution to the first region to form a first coating section completely covering the outer surface of the adjacent cylindrical stent segments in the first region; mixing a second polymer and second therapeutic agent with a second solvent to form a second polymer solution; and applying the second polymer solution to the second region to form a second coating section completely covering the outer surface of the adjacent cylindrical stent segments in the second region, wherein the first

coating section and the second coating section are discrete, and the first region has a longitudinal length greater than the diameter of the stent in an expanded state, as recited in independent claim 11;

a system for producing a coated stent from a stent having a plurality of end-to-end cylindrical stent segments, the axes of the plurality of cylindrical stent segments lying along a longitudinal axis of the stent, the stent having a first region continuous across at least one pair of the adjacent cylindrical stent segments and a second region continuous across at least one pair of the adjacent cylindrical stent segments, including means for mixing a first polymer and first therapeutic agent with a first solvent to form a first polymer solution; means for applying the first polymer solution to the first region to form a first coating section completely covering the outer surface of the adjacent cylindrical stent segments in the first region; and means for mixing a second polymer and second therapeutic agent with a second solvent to form a second polymer solution; and means for applying the second polymer solution to the second region to form a second coating section completely covering the outer surface of the adjacent cylindrical stent segments in the second region, wherein the first coating section and the second coating section are discrete, and the first region has a longitudinal length greater than the diameter of the stent in an expanded state, as recited in independent claim 18; or

a coated stent including a stent having a plurality of end-to-end cylindrical stent segments, the axes of the plurality of cylindrical stent segments lying along a longitudinal axis of the stent, the stent having a discrete first region continuous across at least one pair of the adjacent cylindrical stent segments and a discrete second region continuous across at least one pair of the adjacent cylindrical stent segments; a first polymer including a first therapeutic agent, the first polymer disposed on and completely covering the outer surface of the adjacent cylindrical stent segments in the discrete first region as a first coating section; and a second polymer including a second therapeutic agent, the second polymer disposed on

and completely covering the outer surface of the adjacent cylindrical stent segments in the discrete second region as a second coating section, wherein the first coating section and the second coating section are discrete, and the discrete first region has a longitudinal length greater than the diameter of the stent in an expanded state, as recited in independent claim 22.

At most, the *Castro* patent discloses that composition 10 is applied into cavities 78 within surface 70 of prosthesis 12. *See* column 16, lines 35-37; column 16, lines 35-37; Figures 11A-12D, 13F-13H, 14E, and 14F.

Claims 12-17; claims 19-21; and claims 23-25 depend directly or indirectly from independent claims 11, 18, and 22, respectively, and so include all the elements and limitations of their respective independent claims. The Applicant therefore submits that the dependent claims are allowable over the *Castro* patent for at least the same reasons as set forth above with respect to their independent claims.

Withdrawal of the rejection of claims 11-25 under 35 U.S.C. §103(a) as being unpatentable over the *Castro* patent is respectfully requested

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-5021.

Respectfully submitted,
/Alan M. Krubiner, Reg. No. 26,289/
Alan M. Krubiner
Registration No. 26.289
Attorney for Applicant

Medtronic Vascular, Inc.
3576 Unocal Place
Santa Rosa, CA 95403
Facsimile No.: (707) 543-5420